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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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CANADA

EXAMINER

TODD, GREGORY G

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/808,170

Applicant(s)

ST-DENIS, DANNY

Examiner

Gregory G. Todd

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This is a second office action in response to applicant's amendment filed, 03 June 2005, of application filed, with the above serial number, on 15 March 2001 in which claims 6 and 9 have been amended. Claims 1-10 and 19-20 are therefore pending in the application.
2. The declaration filed on 03 June 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Koza reference.
3. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Koza reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). In this case, there is nothing in the submitted specification or claims identifying anything related to gaming, gaming servers, gaming over a communication network, and gaming based on location, as well as the Abstract page being blank. In addition, there has not been filed a certified copy of either 2,301,474 nor 2,320,413 Canada applications for priority verification. It is recommended Applicant clearly point out and reference each limitation in the claims, especially those the Examiner has referenced to as lacking, having priority in the specification/ claims submitted 03 June 2005 and the

Art Unit: 2157

Canada applications. Further, Applicant is advised to see MPEP Chapter 2300 for information related to interference proceedings, as the Application's claims might be obvious in view of the Koza claims.

***Priority***

4. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Canada on 15 March 2000. It is noted, however, that applicant has not filed a certified copy of the 2,301,474 application as required by 35 U.S.C. 119(b).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2, 4-5, 10 and 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Koza (hereinafter "Koza", 6,767,284).

As per Claim 1, Koza teaches a method of gaming over a communication network comprising the steps of:

an end user sending a request to an Internet Service Provider (ISP) to access a gaming Web site (at least col. 6, lines 52-60; player contacting operator of skill game);

said ISP forwarding said request to a Gaming Server for said gaming Web site, including ISP location data (at least col. 7, lines 52-65; determining IP address of ISP originating communication to operator of skill game); and

said Gaming Server responding to said ISP being in an acceptable location by allowing access to said gaming Web site (at least col. 7, lines 33-41; if eligible, providing access to site).

As per Claim 2.

The method as claimed in claim 1, wherein said communication network comprises an Internet network (at least col. 6, lines 46-51).

As per Claim 4.

The method as claimed in claim 2, wherein said ISP location data comprises the IP address of said ISP (at least col. 7, lines 52-65; col. 15, lines 50-53).

As per Claim 5.

The method as claimed in claim 2, wherein said ISP location data comprises an address indicated by said ISP (at least col. 7, lines 52-65; col. 15, lines 50-53).

As per Claim 10, Koza teaches a system for gaming over a communication network comprising:

an end user (at least col. 6, lines 52-60; player);

an Internet Service Provider (ISP) (at least col. 7, lines 52-65);

a Gaming Server having a gaming Web site (at least col. 6, lines 52-60; internet site of skill game); and

a communication network for interconnecting said end user, said ISP and said Gaming Server (at least col. 6, lines 46-51);

said end user being operable to:

send a request to an Internet Service Provider (ISP) for access to said gaming Web site (at least col. 6, lines 52-60; player contacting operator of skill game);

said ISP being operable to:

forward said request to said Gaming Server, including ISP location data (at least col. 7, lines 52-65; determining IP address of ISP originating communication to operator of skill game); and

said Gaming Server being operable to:

respond to said ISP being in an acceptable location by allowing access (at least col. 7, lines 33-41; if eligible, providing access to site).

Claims 19 and 20 do not add or define any additional limitations over claim 1 and therefore are rejected for similar reasons.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2157

8. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koza in view of Schmuelling et al (hereinafter "Schmuelling", 6,603,758).

As per Claim 3.

Koza teaches the method as claimed in claim 2, but fails to teach wherein said ISP location data comprises the media access control (MAC) address of said ISP. However, the use and advantages for using such an address is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Schmuelling (at least col. 4, lines 53-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Schmuelling's MAC address into Koza's use of using the IP address for verification as Schmuelling teaches a MAC address or IP address being used and offering the same capabilities and goals of authenticating a location and user/provider according to a guaranteed and authenticated source.

As per Claim 6.

Koza and Schmuelling teach the method as claimed in claim 3, further comprising the step of said ISP responding to the physical location of said end user being indeterminant by rejecting said request for access (at least Koza col. 7, lines 22-41).

9. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koza in view of Schmuelling and further in view of Alcorn et al (hereinafter "Alcorn", 6,104,815).

Art Unit: 2157

As per Claim 7.

Koza and Schmuelling teach the method as claimed in claim 6, but fail to teach wherein said request is encrypted. However, the use and advantages for using such encryption is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Alcorn (at least col. 6, lines 33-59). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Alcorn's various encryption methods into Koza and Schmuelling's system as this is very well known and would enhance and offer the security of gaming systems into Koza and Schmuelling's system as Koza teaches the ultimate goal of having authentic gaming sessions wherein a user is identified at a correct location and Koza further teaches encrypting some submissions in a game session (at least col. 24, lines 55-65).

As per Claim 8.

Koza, Schmuelling, and Alcorn teach the method as claimed in claim 7, wherein said step of sending a request further comprises sending an account name and password (at least Koza col. 9, lines 4-12).

As per Claim 9, Koza teaches a method of gaming over an Internet communication network comprising the steps of:

an end user sending a request to an Internet Service Provider (ISP) to access a gaming Web site, including an account name and password (at least col. 6, lines 52-60; col. 9, lines 4-12; player contacting operator of skill game with username and password);



Art Unit: 2157

said ISP:

responding to the physical location of said end user being indeterminant by rejecting said request for access (at least col. 7, lines 22-41); and

forwarding said request to a Gaming Server for said gaming Web site, via said Internet network, including the address of said ISP (at least col. 7, lines 52-65; determining IP address of ISP originating communication to operator of skill game);

said Gaming Server:

responding to said account name and password of said end user corresponding to a valid account, and said address of said ISP being in an acceptable location by allowing said end user to access said gaming Web site (at least col. 7, lines 33-41; if eligible, providing access to site).

Koza fails to teach the ISP location data comprising the media access control (MAC) address of said ISP. However, the use and advantages for using such an address is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Schmuelling (at least col. 4, lines 53-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Schmuelling's MAC address into Koza's use of using the IP address for verification as Schmuelling teaches a MAC address or IP address being used and offering the same capabilities and goals of authenticating a location and user/provider according to a guaranteed and authenticated source.

Art Unit: 2157

Koza and Schmuelling fail to teach the request being encrypted. However, the use and advantages for using such encryption is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Alcorn (at least col. 6, lines 33-59). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Alcorn's various encryption methods into Koza and Schmuelling's system as this is very well known and would enhance and offer the security of gaming systems into Koza and Schmuelling's system as Koza teaches the ultimate goal of having authentic gaming sessions wherein a user is identified at a correct location and Koza further teaches encrypting some submissions in a game session (at least col. 24, lines 55-65).

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Previously cited Hrastar et al, Paravia et al, Angles et al, Merriman et al, and Kass are cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory G. Todd whose telephone number is (571)272-4011. The examiner can normally be reached on Monday - Friday 9:00am-6:00pm w/ first Fridays off.

Art Unit: 2157


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory Todd

Patent Examiner

Technology Center 2100



ABDULHADI SALIM  
Primary Examiner